

Response to Office 10/26/2007 Communication

REMARKS/ARGUMENTS

Summary Of Examiner's October 26, 2007 Communication

On September 19, 2007, the Board of Patent Appeals and Interferences for the US Patent and Trademark Office (“Board”) issued an Order remanding this Application back to the Examiner for further action. Specifically, the Board made the following observations regarding the Rule 1.132 Declaration of Sherry Daskal (“Daskal Declaration”) filed with the Applicant’s Appeal Brief on October 18, 2002, and the Rule 1.132 Declaration of Rabbi Shmuel Neiman (“Neiman Declaration”) submitted by the Applicant on January 23, 2002:

(1) the record is not clear as to whether the Daskal Declaration was entered and considered by the Examiner;

(2) the record is not clear as to whether the Neiman Declaration was considered by the Examiner; and

(3) the Daskal and Neiman Declarations (collectively, the “Original Declarations”, copies attached hereto as Exhibit 1) do not meet the requirements of 37 C.F.R. §§ 1.132 and 1.68 since they do not include a warning that willful statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. § 101, and may jeopardize the validity of the application or any patent issuing thereon.

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In response to the Board's Order, on October 26, 2007, the Examiner considered the Daskal and Neiman Declarations, and held that these Declarations do not overcome her prior obviousness rejection of Claims 1 and 5-7. The Examiner also objected to both Declarations under 37 C.F.R. §§ 1.68, 1.132 for the reasons set forth in the Board's September 19, 2007 Order.

Supplemental Declarations

Applicant submits herewith the "Supplemental Rule 1.132 Declaration of Rabbi Shmuel Neiman" and the "Corrected Rule 1.132 Declaration of Sherry Daskal" ("collectively, the "Supplemental Declarations" copies attached hereto as Exhibit 2), both of which acknowledge that, at the time the Original Declarations were made, the statements therein were (and continue to be) made with the knowledge that willful false statements and the like are punishable by fine, imprisonment or both under 18 USC § 1001, and that such willful false statements may jeopardize the validity of this patent application or any patent issued thereon. Thus, it is respectfully submitted that the Original Declarations and the Supplemental Declarations meet the requirements of Rules 1.68 and 1.132. As such, the Applicant respectfully requests that the Examiner enter the Original and Supplemental Declarations on the record and consider the same, to the extent she has not already done so.

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Claims 1 and 5-7 Are Not Obvious

Applicant respectfully submits that the Examiner's Section 103 rejection of Claims 1 and 5-7 is not based on factually accurate grounds. In this regard, the Examiner bases her obviousness rejection of Claims 1 and 5-7 on the mistaken belief that "the Declarations state that the claimed invention provides a solution to the long-felt need of a feminine hygiene article having a topsheet that masks stains." In this regard, the Examiner reasons that "the prior art of record explicitly teaches providing a topsheet that masks stains ... regardless of the source of the long-felt need, the solution has already been disclosed in the prior art of record. The relative lightness or darkness of the topsheet is an obvious modification to the invention, as described in the Examiner's Answer dated 3 October 2003." Applicant respectfully disagrees.

The purpose of the claimed invention does not relate to the masking of stains. Indeed, as Rabbi Neiman states, "whether a colored surface masks or does not mask a stain is irrelevant" to the claimed invention. Neiman Declaration, Par. 7 (emphasis added). Rather, what is relevant is whether a stain falls under one of the exceptions to the Rabbinic Decree relating to whether a woman has the status of a *Niddah*. *Id.*, at Pars. 4, 7-8.

Moreover, contrary to the Examiner's suggestion, a dark top sheet would not necessarily mask non-menstrual stains. For example, as noted by Ms. Daskal, *Leukorrhea*

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or other light non-menstrual stains that she experienced after the birth of her second child were in fact not masked by a black feminine hygiene pad that she had used. *See* Daskal Declaration, Pars. 4-5. Rather, these light (e.g., white) stains were very noticeable on the black topsheet. *Id.* Thus, if a light non-menstrual stain falls on a woman's light colored feminine hygiene pad, the woman would be rendered a *Niddah*, even though the stain would be masked. The same non-menstrual stain on the claimed dark colored surfaces, by contrast, would not be masked, yet this stain would not render the woman a *Niddah*. Thus, the masking of a stain in this example actually teaches away from the claimed invention.

Moreover, as Rabbi Neiman notes in his declarations, the light colored surfaces of the prior art (e.g., blue, green, etc.) do not fall under the colored-surface exception to the Rabbinic Decree concerning *Niddah* because they are not dark surfaces, like those of the claimed invention. See January 14, 2002 Neiman Declaration, Pars. 7, 8.

Since the prior art does not disclose the claimed dark, black, brown and red top sheets, it is respectfully submitted that the claims are allowable over the prior art.

The Long Delay In The Prosecution Of This Application

Applicant would be remiss if it did not comment on the long series of events that occurred during the Appeal of this Application which have caused undue prejudice to the Applicant.

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The Applicant originally filed an Appeal Brief on October 18, 2002. MPEP 1208 requires that the Examiner's Answer should have been filed within two months of the Applicant's Appeal Brief (i.e., no later than December 18, 2002). As summarized in detail in Applicant's November 26, 2003 Reply Brief (see pp. 3-4), after learning from the Board that the Appeal Brief was never forwarded to it by the Examiner, Applicant's counsel contacted the Examiner by telephone to inquire about this delay. The Examiner indicated that she would be withdrawing her Final Rejection and issuing a new Office Action based on newly found prior art. This never happened, and instead, on October 3, 2003 and without explanation, the Examiner filed an Answer, nearly 10 months after she was required to do so.

On May 16, 2005 and nearly two years later, the Board issued an Order Returning the Undocketed Appeal to the Examiner. In this Order, the Board noted that the Examiner never initialed the Information Disclosure Statement ("IDS") that was filed with the Appeal Brief on October 18, 2002. The Examiner was ordered to consider the IDS, which disclosed a single design patent. Nearly one year after the Board's Order, on April 6, 2006, the Examiner initialed the IDS. The Appeal Brief was then returned to the Board and docketed.

On September 19, 2007, more than one year after the Examiner initialed the IDS (and nearly five years after the Appeal Brief was filed), the Board issued yet another Order remanding the case to the Examiner. This time, the Board noted that the

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Examiner never indicated in her Answer (or any other papers of record) whether she considered the Neiman and Daskal Declarations. The Board ordered the Examiner to indicate whether the Declarations have been entered and considered, and if so, how they factor into the Examiner's obviousness rejection of the claims. Significantly, the Applicant specifically noted in his November 26, 2003 Reply Brief that the Examiner did not respond to the Neiman Declaration. (See Reply Brief at 6). Clearly, the Original Declarations should have been considered long ago.

As a result of these long and unexplained delays, the Applicant, who is a sole inventor with limited resources, has been unduly prejudiced. For example, a black panty liner has been sold by McNeill-PPC in the United States. Moreover, Applicant has expended significant resources and effort in addressing the foregoing problems. Additionally, Applicant had to track down Rabbi Neiman and ask him to once again execute the Declaration. Due to circumstances beyond Applicant's control, including the nearly six years that have passed since the Appeal Brief was filed, Applicant was unable to get Rabbi Neiman to execute his new Declaration until very recently.

It has been nearly eight years since this application was filed, and nearly six years since the Applicant's Appeal Brief was filed. Applicant would like to schedule a Telephonic Interview with the Examiner and the Primary Examiner to discuss what steps can be taken to remedy this situation, and quickly move toward a favorable resolution of this matter.

EFS
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No fees or extensions of time are believed to be due in connection with this Communication. However, authorization is hereby provided to charge Deposit Account No. 01-1785 should any fees be due.

Respectfully submitted

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July 22, 2008

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Attachments: Exhibit 1 - Copies of Original Declarations of Daskal and Neiman
Exhibit 2 - Copies of Supplement Declarations of Daskal and Neiman